

REMARKS

Applicant has amended claims 17, 24, and 27-28, and cancelled claims 1-12, during prosecution of this patent application. Applicant is not conceding in this patent application that the subject matter encompassed by said amended and cancelled claims are not patentable over the art cited by the Examiner, since the claim amendments and cancellations are only for facilitating expeditious prosecution of this patent application. Applicant respectfully reserves the right to pursue the subject matter encompassed by said amended and cancelled claims, and to pursue other claims, in one or more continuations and/or divisional patent applications.

The Examiner objected to claims 21-22 and 31-32 under 37 CFR 1.75(c) as allegedly being of improper dependent form for failing to further limit the subject matter of a previous claim.

In a telephonic interview on May 8, 2009 between Examiner Sarah Su and Applicant's Representative Jack P. Friedman, the objection to claims 21-22 and 31-32 was discussed, and it was agreed that in the present after-final response, Applicant would present new argumentation in traversal of the objection to claims 21-22 and 31-32 in addition to arguments previously presented, and that the Examiner would give consideration to such Applicant's arguments.

The Examiner rejected claims 13, 15, 17-26 and 28-32 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Murakawa (US 2005/0005097 A1) in view of Bhaskaran et al. (US 2005/0188203 A1 and Bhaskaran hereinafter).

The Examiner rejected claim 14 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Murakawa in view of Bhaskaran as applied to claim 13 above, and further in view of Helpfile of Version 2.0 of MP3 Tag Clinic (XP-002334789 and Helpfile hereinafter).

The Examiner rejected claims 16 and 27 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Murakawa in view of Bhaskaran as applied to claim 13 above, and further in view of DiPierro (US 2003/0088783 A1).

Applicant respectfully traverses the claims objections and § 103 rejections with the following arguments.

Claim Objections: Claims 21-22 and 31-32

The Examiner objected to claims 21-22 and 31-32.

The Examiner argues: “Claims 21-22 and 31-32 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claims 21 and 31 recite a computer readable medium comprising instructions to perform the method of claims 13 and 23, respectively. Claims 22 and 32 recite a system comprising a computer readable medium comprising instructions to perform the method of claims 13 and 23, respectively, and means for executing these instructions. These limitations do not further limit claims 13 and 23.”

In response, Applicants notes that the Examiner has cited 37 CFR 1.75(c) which recites the following patent rule: “One or more claims may be presented in dependent form, referring back to and further limiting another claim or claims in the same application... Claims in dependent form shall be construed to include all the limitations of the claim incorporated by reference into the dependent claim.”

Applicants next cite 35 U.S.C. § 112, fourth paragraph which recites the patent law that provides the legal foundation for the patent rule in the preceding citation from 37 CFR 1.75(c). In particular, 35 U.S.C. § 112, fourth paragraph recites: “a claim in dependent form shall contain a reference to a claim previously set forth and then specify a further limitation of the subject matter claimed. A claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers.”

MPEP § 608.01(n) III explains that the meaning of the preceding citation in 35 U.S.C. § 112, fourth paragraph is governed by the infringement test. In particular, MPEP § 608.01(n) III recites:

“The test as to whether a claim is a proper dependent claim is that it shall include every limitation of the claim from which it depends (*35 U.S.C. 112, fourth paragraph*) or in other words that it shall not conceivably be infringed by anything which would not also infringe the basic claim... A dependent claim does not lack compliance with 35 U.S.C. 112, fourth paragraph, simply because there is a question as to (1) the significance of the further limitation added by the dependent claim, or (2) whether the further limitation in fact changes the scope of the dependent claim from that of the claim from which it depends. *The test for a proper dependent claim under the fourth paragraph of 35 U.S.C. 112 is whether the dependent claim includes every limitation of the claim from which it depends. The test is not one of whether the claims differ in scope. ...*” (emphasis added)

Thus, Applicants respectfully contend that the Examiner has applied an incorrect test of whether claims 21-22 and 31-32 are narrower in scope than claims 13 and 23 from which claims 21-22 and 31-32 respectively depend.

Applicants assert that claims 21-22 and 31-32 satisfy the correct legal test for compliance with 35 U.S.C. 112, fourth paragraph, namely the test of whether 21-22 and 31-32 include every limitation of claims 13 and 23, respectively.

In further response, Applicants respectfully assert that claims 21-22 and 31-32 further limit performance of the method of claims 13 and 23, respectively, as follows.

Claim 21 limits performance of the method of claim 13 to being performed by instructions comprised by the computer readable medium. The preceding limitation for performing the method does not exist in claim 13.

Claim 22 limits performance of the method of claim 13 to being performed by instructions comprised by the computer readable medium in accordance with means for executing the instructions. The preceding limitations for performing the method does not exist in claim 13.

Claim 31 limits performance of the method of claim 23 to being performed by instructions comprised by the computer readable medium. The preceding limitations for performing the method does not exist in claim 23.

Claim 32 limits performance of the method of claim 13 to being performed by instructions comprised by the computer readable medium in accordance with means for executing the instructions. The preceding limitations for performing the method does not exist in claim 23.

In addition, Applicants respectfully contend that the objection to claims 21-22 and 31-32 is significantly inconsistent with the policy of the United States Patent and Trademark Office (USPTO) which has issued hundreds if not thousands of patents of the same form as claims 21-22 and 31-32. For illustrative purposes, Applicants cite the following 5 such patents issued *just within the past four weeks*:

United States Patent 7,529,198 issued May 5, 2009 to Jain et al. (claim 8);

United States Patent 7,527,497 issued May 5, 2009 to Matsuoka (claim 9);

United States Patent 7,523,304 issued April 21, 2009 to Gentry et al. (claim 5);
United States Patent 7,522,369 issued April 21, 2009 to Rahgozar et al. (claim 13);
United States Patent 7,519,212 issued April 14, 2009 to Brody et al. (claim 17).

Applicant reiterates that the preceding 5 patents were issued just within the last 4 weeks, which implies that the total number of such issued patents in the past having claims of the same form as claims 21-22 and 31-32 is most likely overwhelming.

Based on the preceding arguments, Applicant respectfully requests that the objection to claims 21-22 and 31-32 be withdrawn.

35 U.S.C. § 103: Claims 13, 15, 17-26 and 28-32

The Examiner rejected claims 13, 15, 17-26 and 28-32 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Murakawa (US 2005/0005097 A1) in view of Bhaskaran et al. (US 2005/0188203 A1 and Bhaskaran hereinafter).

Claims 13, 15, and 17-22

Applicant respectfully contends that claim 13 is not unpatentable over Murakawa in view of Bhaskaran, because Murakawa in view of Bhaskaran does not teach or suggest each and every feature of claim 13.

A first example of why claim 13 is not unpatentable over Murakawa in view of Bhaskaran is that Murakawa in view of Bhaskaran does not teach or suggest the feature: “receiving, from a certification authority (CA) who issued a digital certificate, a private key associated with the digital certificate and a certificate address from which the digital certificate may be accessed”.

The Examiner argues: “Murakawa discloses ... **receiving, from a certification authority (CA) (i.e. device) who issued a digital certificate, a private key associated with the digital certificate and a certificate address (i.e. list of certificates) from which the digital certificate may be accessed** (0031, lines 1-3, 7-10)”

In response, Applicant asserts that Murakawa, Par. 0031, lines 4-10 discloses that the device 100 creates and sends a digital certificate (i.e., a self-made certificate) to the client 200. Thus, the Examiner is arguing that device 100 represents the claimed certification authority from

which the digital certificate is received by the client 200. However, Murakawa, Par. 0031 does not disclose that the self-made certificate, a private key, and a certificate address (from which the digital certificate may be accessed) are sent to the client 200.

As to the private key, it is clear from Murakawa, FIG. 5 that both the root certificate and the self-made certificate at the device 100 include both a private key and a public key. However, it is also clear from Murakawa, FIG. 5 that only the public key and not the private key is received by the client 200 from the device 100 for both the root certificate and the self-made certificate. Therefore, Murakawa does not disclose “receiving, from a certification authority (CA) who issued a digital certificate, a private key associated with the digital certificate ...”.

As to the certificate address from which the digital certificate may be accessed, the Examiner argues that the list of certificates and the self-made certificate received by the client 200 from the device 100 satisfies the claim limitation of “receiving, from a certification authority (CA) who issued a digital certificate, ... a certificate address from which the digital certificate may be accessed”. However, the disclosure in Murakawa, Par. 0031 of a list of certificates is not a disclosure of a certificate address from which the digital certificate may be accessed. Applicants assert that the list of certificates is mentioned in Murakawa, Par. 0031 in conjunction with a chain of certificates. Thus, the list of certificates that is sent by the device 100 to the client 200 is an identification of the certificates that are in the chain of certificates. There is no disclosure in Murakawa, Par. 0031 the list of certificates include a certificate address from which the digital certificate may be accessed.

Therefore, Murakawa in view of Bhaskaran does not disclose the preceding feature of claim 13.

A second example of why claim 13 is not unpatentable over Murakawa in view of Bhaskaran is that Murakawa in view of Bhaskaran does not teach or suggest the feature: “generating a digital signature based on the file and the received private key”.

The Examiner argues that Murakawa, Par. 0005, lines 21-22 and 24-28 disclose the preceding feature of claim 13.

In response, Applicant respectfully contends that Murakawa, Par. 0005, lines 21-22 discloses that generation of the digital certificate is based on a hash value and does not disclose that generation of the digital signature is based on the file and the *received* private key. In fact, there is no disclosure in Murakawa of a private key that is *received*, as explained *supra* in conjunction with the first example.

Therefore, Murakawa in view of Bhaskaran does not disclose the preceding feature of claim 13.

A third example of why claim 13 is not unpatentable over Murakawa in view of Bhaskaran is that Murakawa in view of Bhaskaran does not teach or suggest the feature: “encoding the received certificate address to generate an encoded address”.

The Examiner acknowledges that Murakawa does not disclose the preceding feature of claim 13, but argues that Bhaskaran, Par. 0017, lines 10-11 disclose the preceding feature of claim 13.

In response, Applicant respectfully contends that Bhaskaran, Par. 0017, lines 10-11 discloses: “In FIG. 2, dynamic data 120 are shown as being encoded”. However, Bhaskaran, Par. 0017 does not disclose that the dynamic data 120 being encoded is a certificate address, as

required by the preceding feature of claim 13. In fact, in Bhaskaran, FIG. 2, examples of the dynamic data 120 to be “settings, parameters, contract nos., order receipts, etc.” and are not stated to include a certificate address.

In “Response to Argument”, the Examiner argues: “Further as to claim 13, it is argued by the applicant that Bhaskaran does not disclose that the dynamic data being encoded is a certificate address. The examiner respectfully disagrees. Bhaskaran discloses that dynamic data may be contact phone numbers, settings, parameters, order receipts as well as other information such as software configuration information which is helpful to the end user or others (0014, lines6-9). It is noted that this list is non-limiting and it would have been obvious to one of ordinary skill in the art at the time of the invention to use a location (i.e. information helpful to end user) as the dynamic data.”

In response, Applicants respectfully contend that the Examiner has erroneously argued that it is obvious to modify Bhaskaran by a feature of claim 13 that is unknown in the prior art. Applicants assert that a rejection of a claim on grounds of obviousness requires that all features of the claim are known in the prior art.

An attempt to show that it is obvious to combine elements to disclose the claimed invention starts with elements that are known in the prior art and then seeks to demonstrate that it is obvious to combine the elements. *KSR Int’l Co. v. Teleflex Inc.*, 82 USPQ2d 1385, 1396 (2007) (“When it first established the requirement of demonstrating a teaching, suggestion, or motivation to combine **known elements** in order to show that the combination is obvious, the Court of Customs and Patent Appeals captured a helpful insight. See *Application of Bergel*, 292 F. 2d 955, 956-957 (1961)”) (emphasis added).

Insight as to why all elements of a claim must be known to reject the claim on grounds of obvious is provided in *In re Shetty*, 566 F.2d 81, 86, 195 USPQ 753, 756-57 (C.C.P.A. 1977) (reversing the Board's rejection of a claim based on alleged inherency under 35 U.S.C. 103 of a method to curb appetite, and stating: "**Obviousness cannot be predicated on what is unknown**"") (emphasis added).

Accordingly, the Examiner's argument that it is obvious to modify Bhaskaran by a feature of claim 13 that is unknown in the prior art (i.e., the feature of "encoding the received certificate address to generate an encoded address") is contrary to established patent law and thus not persuasive.

In addition, as to modifying Murakawa, the Examiner argues: "Bhaskaran recites motivation by disclosing that encoding information into a filename is an efficient way to add information to a software package without destroying the authentication or digital signature (0005, lines 1-3). It is obvious that the teachings of Bhaskaran would have improved the teachings of Bhaskaran by encoding information into a filename in order to add information to the file without destroying authentication information within the file."

In response, Applicants assert that the preceding argument by the Examiner is not persuasive, because the preceding argument by the Examiner does not state motivation for encoding *specifically a certificate address* into a filename.

Therefore, Murakawa in view of Bhaskaran does not disclose the preceding feature of claim 13.

A fourth example of why claim 13 is not unpatentable over Murakawa in view of Bhaskaran is that Murakawa in view of Bhaskaran does not teach or suggest the feature: “merging the existing filename and the encoded address to generate a new filename; and renaming the file with the new filename”.

The Examiner acknowledges that Murakawa does not disclose the preceding feature of claim 13, but argues that Bhaskaran, Par. 0014, lines 13-16 disclose the preceding feature of claim 13.

In response, Applicant respectfully contends that Bhaskaran, Par. 0013, lines 11-13 discloses that the existing filename is “ProductX.exe” and Bhaskaran, Par. 0014, lines 13-16 disclose that the new filename is “ProductX_Y.exe” wherein Y is the dynamic data 120. However, as explained *supra* in conjunction with the third example, Bhaskaran does not disclose that the dynamic data 120 being encoded is a certificate address which the Examiner has acknowledged.

Therefore, Murakawa in view of Bhaskaran does not disclose the preceding feature of claim 13.

Based on the preceding arguments, Applicant respectfully maintains that claim 13 is not unpatentable over Murakawa and in view of Bhaskaran, and that claim 13 is in condition for allowance. Since claims 15 and 17-22 depend from claim 13, Applicant contends that claims 15 and 17-22 are likewise in condition for allowance.

In addition with respect to claims 17 and 28, Murakawa and in view of Bhaskaran does not disclose the feature: “wherein the method further comprises sending the renamed file from an owner of the digital certificate to a user” (claim 17) and “wherein the method further comprises: prior to said extracting, receiving the file from an owner of the digital certificate” (claim 28).

The Examiner argues: “Bhaskaran discloses: **sending the renamed (i.e. wrapped) file from an owner (i.e. distributor) of the digital certificate to a user** (0019, lines 10-12).”

In response, Applicants assert that Bhaskaran does not disclose that a distributor of the digital certificate is an owner of the digital certificate, as required by the preceding feature of claims 17 and 28. Therefore, the preceding argument by the Examiner is not persuasive.

Therefore, Murakawa in view of Bhaskaran does not disclose the preceding feature of claims 17 and 28.

In addition with respect to claim 19, Murakawa and in view of Bhaskaran does not disclose the feature: “wherein the certificate address is an address of a server of the certification authority”.

The Examiner argues that Murakawa, Par. 0029, lines 14-15 and Par. 0041, lines 7-9 disclose the preceding feature of claim 19.

In response, Applicant asserts that the “certificate address” in claim 19 has antecedent basis in “certificate address” in claim 13. Therefore, the recited certificate address in claim 19 is required to be the same the certificate address as in claim 13, which is alleged by the Examiner to be the “list of certificates” recited in Murakawa, Par. 0031. Furthermore, the Examiner has argued in conjunction with claim 13 that the certification authority is the device 100 in

Murakawa. Applicants assert that there is no disclosure in Murakawa, Par. 0029, lines 14-15 and Par. 0041, lines 7-9, or anywhere else in Murakawa, that the list of certificates recited in Murakawa, Par. 0031 is an address of a server of the device 100 as required by claim 19.

Therefore, Murakawa in view of Bhaskaran does not disclose the preceding feature of claim 19.

Claims 23-26 and 28-32

Applicant respectfully contend that claim 23 is not unpatentable over Murakawa and in view of Bhaskaran, because Murakawa and in view of Bhaskaran does not teach or suggest each and every feature of claim 23.

A first example of why claim 23 is not unpatentable over Murakawa in view of Bhaskaran is that Murakawa in view of Bhaskaran does not teach or suggest the feature: “extracting the encoded address from the filename”.

The Examiner argues: “Murakawa discloses: **extracting the encoded address from the filename** (0015, lines 15-17). Given the teaching of Bhaskaran, a person having ordinary skill in the art at the time of the invention would have readily recognized the desirability and advantages of modifying the teachings of Murakawa with the teachings of Bhaskaran by extracting an address from the filename. Please refer to the motivation recited above in respect to claim 13 as to why it is obvious to apply the teachings of Bhaskaran to the teachings of Murakawa.”

In response, Applicants assert that Bhaskaran, Par. 0015, lines 15-17 recite: "The user then reads the new filename to extract this text which may include dynamic data such as settings, parameters, contact numbers, order receipts, etc."

Applicants assert that Bhaskaran, Par. 0015, lines 15-17 does not disclose that the dynamic data includes an encoded address. Since the Examiner cannot find any prior art allegedly disclosing a filename that includes an encoded address, the Examiner cannot make an argument that it is obvious to modify Bhaskaran to include an encoded address in the dynamic data in the filename, as discussed *supra* in conjunction with the cases of *KSR Int'l Co. v. Teleflex Inc.* and *In re Shetty*.

Moreover, the Examiner's statement "Please refer to the motivation recited above in respect to claim 13 as to why it is obvious to apply the teachings of Bhaskaran to the teachings of Murakawa" is not persuasive, because the Examiner's argument for claim 13 stated motivation to encode information into a filename, which is not relevant to the preceding feature of claim 23 of "extracting the encoded address from the filename".

Therefore, Murakawa in view of Bhaskaran does not disclose the preceding feature of claim 23.

A second example of why claim 23 is not unpatentable over Murakawa in view of Bhaskaran is that Murakawa in view of Bhaskaran does not teach or suggest the feature: "decoding the extracted encoded address to generate a certificate address from which a digital certificate may be accessed".

The Examiner argues that Murakawa, Par. 0031, lines 10-14 and Par. 0042, lines 6-8 disclose the preceding feature of claim 23.

In response, Applicant respectively contends that Murakawa, Par. 0031, lines 10-14 disclose decrypting a certificate but does not disclose decoding an address, as required by the preceding feature of claim 13, and Murakawa, Par. 0031, lines 10-14 most certainly does not disclose decoding an encoded address that has been extracted from a filename, as required by the preceding feature of claim 13.

In further response, Applicant notes that Murakawa, Par.0042, lines 6-8 recites “a certificate at the high level (the root certificate in this example) is acquired based on the information in the certificate (S40)”, which is unrelated to the preceding feature of claim 23.

Furthermore, Murakawa, Par. 0031, lines 10-14 and Par. 0042, lines 6-8 does not disclose generating a certificate address from which a digital certificate may be accessed, as required by the preceding feature of claim 23.

In “Response to Arguments”, the Examiner argues: “As to claim 23, it is argued by the applicant that Murakawa does not disclose generating a certificate address from which a digital certificate may be accessed. The examiner respectfully disagrees. Murakawa discloses that a certificate is acquired based on the information in the certificate (i.e. location) and that the information is inputted (i.e. generated) by a user (0041, lines 3-4, 6-8).”

In response, Applicants assert that the preceding argument by the Examiner based on Murakawa, Par. 0041, lines 3-8 relates to generating a certificate based on user input, but does not relate to generating a certificate address from which a digital certificate may be accessed as required by the preceding feature of claim 23.

Therefore, Murakawa in view of Bhaskaran does not disclose the preceding feature of claim 23.

A third example of why claim 23 is not unpatentable over Murakawa in view of Bhaskaran is that Murakawa in view of Bhaskaran does not teach or suggest the feature: “accessing the digital certificate from the generated certificate address”.

The Examiner argues that Murakawa, Par. 0042, lines 6-8 disclose the preceding feature of claim 23.

In response, Applicant notes that Murakawa, Par.0042, lines 6-8 recites “a certificate at the high level (the root certificate in this example) is acquired based on the information in the certificate (S40)”, which does not disclose that the digital certificate is accessed from the generated certificate address which is an address generated from an encoded address in a filename as claimed.

Therefore, Murakawa in view of Bhaskaran does not disclose the preceding feature of claim 23.

Based on the preceding arguments, Applicants respectfully maintain that claim 23 is not unpatentable over Murakawa and in view of Bhaskaran, and that claim 23 is in condition for allowance. Since claims 24-26 and 28-32 depend from claim 23, Applicants contend that claims 24-26 and 28-32 are likewise in condition for allowance.

35 U.S.C. § 103(a): Claim 14

The Examiner rejected claim 14 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Murakawa in view of Bhaskaran as applied to claim 13 above, and further in view of Helpfile of Version 2.0 of MP3 Tag Clinic (XP-002334789 and Helpfile hereinafter).

Since claim 14 depends from claim 13 which Applicants have argued *supra* to not be unpatentable over Murakawa in view of Bhaskaran under 35 U.S.C. §103(a), Applicants maintain that claim 14 is likewise not unpatentable over Murakawa in view of Bhaskaran, and further in view of Helpfile under 35 U.S.C. §103(a).

35 U.S.C. § 103(a): Claims 16 and 27

The Examiner rejected claims 16 and 27 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Murakawa in view of Bhaskaran as applied to claim 13 above, and further in view of DiPierro (US 2003/0088783 A1).

Since claims 16 and 27 depend from claims 13 and 23, respectively, which Applicants have argued *supra* to not be unpatentable over Murakawa in view of Bhaskaran under 35 U.S.C. §103(a), Applicants maintain that claims 16 and 27 are likewise not unpatentable over Murakawa in view of Bhaskaran, and further in view of DiPierro under 35 U.S.C. §103(a).

In addition with respect to claims 16 and 27, Murakawa in view of Bhaskaran, and further in view of DiPierro does not disclose the feature: “wherein the file comprises a document, wherein said signing the file comprises appending the generated digital signature to the file such that the generated digital signature is disposed between a beginning tag and an ending tag at the beginning of the file before the document”.

The Examiner argues that DiPierro, Par. 0039, lines 2-3 discloses the preceding feature of claims 16 and 27.

In response, Applicants note that DiPierro, Par. 0039, lines 1-3 recites: “One embodiment of the invention uses an algorithm to generate a digital signature for authentication, stores that digital signature in the file header or otherwise with the file, and then encrypts the digital signature together with the data in the file.”

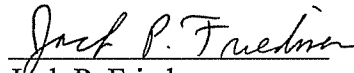
Although DiPierro, Par. 0039, lines 1-3 discloses that the generated digital signature is disposed in the file header, DiPierro, Par. 0039, lines 1-3 does not disclose that the generated digital signature is disposed in the file header between a beginning tag and an ending tag.

Therefore, claims 16 and 27 are not unpatentable over Murakawa in view of Bhaskaran,
and further in view of DiPierro

CONCLUSION

Based on the preceding arguments, Applicant respectfully believes that all pending claims and the entire application meet the acceptance criteria for allowance and therefore request favorable action. If the Examiner believes that anything further would be helpful to place the application in better condition for allowance, Applicant invites the Examiner to contact Applicant's representative at the telephone number listed below. The Director is hereby authorized to charge and/or credit Deposit Account 09-0457 (IBM).

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